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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,362	06/27/2003	Akm Kamrul Alam	END920030036US1	8152

26502	7590	08/24/2006	EXAMINER

IBM CORPORATION
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EXAMINER
VU, TUAN A

ART UNIT	PAPER NUMBER
2193	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/609,362	ALAM, AKM KAMRUL
	Examiner	Art Unit	
	Tuan A. Vu	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>27 June 2003</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-8</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-8</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>27 June 2003</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the application filed 6/27/2003.

Claims 1-8 have been submitted for examination.

Drawings

2.   New corrected drawings in compliance with 37 CFR 1.121(d) are required in this

application because the current drawings (Figures 1-4, filed 6/27/03) exhibit casual scribbling

and/or hand-written elements such as texts and numerals that make it very hard to decipher or to

map many such elements against the corresponding description in the specification. Applicant is

advised to employ the services of a competent patent draftsperson outside the Office, as the U.S.

Patent and Trademark Office no longer prepares new drawings. The corrected drawings are

required in reply to the Office action to avoid abandonment of the application. The requirement

for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   Claims 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter.

> The Federal Circuit has recently applied the practical application test in determining whether the claimed
> subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a " useful,
> concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a
> patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the
> "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a
> concrete, tangible, and useful result. The test for practical application is thus to determine whether the
> claimed invention produces a "useful, concrete and tangible result".

Specifically, claim 5 recites a system for building a server, comprising multiplicity of program objects to install applications on said server; means for determining which objects with prerequisite parameters for said applications; means for invoking said objects, so that one or more of these objects when executed invoke other objects with more parameters. From the Specifications a Control Program (e.g. Fig. 2 and corresponding text) is executed to determine associated applications based on a control file to invoke appropriate installation objects. It is evident that *means* for *determining* and *invoking* as claimed are software implemented; and that objects are software entities (or program code) being invoked from the so-disclosed (software) means which are otherwise construed as mere descriptive functional elements. Nowhere in the claim is there any reasonable teaching that these functional software means/objects are stored in tangible medium so that when executed --by a hardware support coupled with this medium, enable the realization of said functionality into real-world output, e.g. via machine executing of those software entities. Therefore, the claim fails to reasonably convey that the recited software functionality can be realized to yield real-world data/output that would be construed as concrete, useful and tangible result. The claim as a whole amounts to a non-practical application and is rejected for leading to a non-statutory subject matter.

Claims 6-8 are also rejected for failing to convey a tangible medium to store the software functional elements in order to materialize said functionality, thus to make the invention a Practical Application.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Mastrianni et al.,

2002/0178233 (hereinafter Mastrianni)

        The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

        As per claim 1, Mastrianni discloses a computer program product for building a

server(*as a server* – para 0032, pg. 2; *management server 416* – para 0085, pg. 6) according to

specifications, said program product comprising:

        a computer readable medium; a multiplicity of program objects (e.g. *file functions 404,*

driver 410 – Fig. 4) to install a respective multiplicity of applications on said server (application

408 – Fig. 4; para 0044, pg.3);

        first program instructions to determine a plurality of said program objects which currently

have prerequisite software and parameters (...*list of files meeting extension ...application is*

installed... extension associated - para 0043-0044, pg. 3; list *1604* – Fig. 16 – Note: identifier of

files or locations reads on parameters – see *Names and Locations 132* – Fig. 13-14) for their

respective applications;

        second program instructions to concurrently invoke said plurality of program objects (e.g.

para 0045-0046, pg. 4); and

wherein at least one of said plurality of program objects, after execution, invokes another

of said program objects (e.g. para 0050 – pg. 4 – Note: change in files being hooked by call to

driver components so that allocation related to files – parameter in update list , see Fig. 14 - are

updated consistent with repeated requests by application triggered hooks leading to more file

functions and driver calls **reads on** 'invokes another of said program objects, supplying further

prerequisite' – like file identifier or locations, see Fig. 13-14, 16 -- for said other program from

the very deed of installing an application), supplying a prerequisite parameter for said other

program object ; and

wherein said program objects and said first and second program instructions are recorded

on said medium (Fig. 1, Fig. 2).

As per claim 2, Mastrianni discloses wherein said parameter supplied by said other

program object was generated by the application (e.g. para 0077-0080, pg. 6; Fig. 13-14)

installed by said other object.

As per claim 3, Mastrianni discloses program instructions to prompt a user to furnish

parameters (*user input ... select files* - para 0085-0086, pg. 6) for said plurality of program

objects; and wherein said third program instructions are recorded on said medium.

As per claim 4, Mastrianni discloses computer program product as set forth in claim 1

wherein

a first one of said plurality of program objects installs distributing computing software

(e.g. Fig. 5 – Note: files handling from application request or caller regarding storage locations in

file system reads on distribution computing software as depicted in Fig. 13-14),

a second one of said plurality of program objects installs data base management software

(e.g. database 412 – Fig. 4; Fig. 9– Note: migration of files as depicted in Fig. 15-16 reads on

server installing all files related to management of database as in Fig. 11-12) and

a third one of said plurality of program objects installs prerequisite software for WWW

server software (para 0085-0086, pg. 6 – Note: user selecting of files for migration of

applications on server read on server software).

As per claim 5, Mastrianni discloses a computer system for building a server according

to specifications, said system comprising:

a multiplicity of program objects to install a respective multiplicity of applications on

said server; means for

determining a plurality of said program objects which currently have prerequisite

software and parameters for their respective applications; and

concurrently invoking said plurality of program objects; and

wherein at least one of said plurality of program objects, after execution, invokes another

of said program objects, supplying a prerequisite parameter for said other program object;

all of which limitations having been addressed on claim 1.

As per claims 6-7, the subject matter therein corresponds to that of claims 2-4; hence these will

incorporate the respective rejection as set forth therein.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The

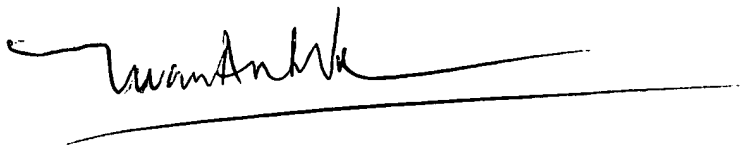examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is

assigned is (571) 273-3735 (for non-official correspondence - please consult Examiner before

using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-

272-3609.

Any inquiry of a general nature or relating to the status of this application should be

directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan A Vu
Patent Examiner,
Art Unit 2193
August 18, 2006